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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/932,784

09/18/1997

JAMES A. MCKAIN

A0521/7125

5693

26643

7590

11/03/2004

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EXAMINER

NGUYEN, HUY THANH

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/932,784

Applicant(s)

MCKAIN ET AL.

Examiner

HUY T NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,9 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,9 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>43</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 05 August 2004 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters et al (5,946,445) in view of Kojima et al (5,168,363)..

Regarding claims 1, 9 and 23, Peters discloses a digital motion picture recorder comprising:

- a housing sized to be portable for use by an individual (Fig. 1);
- processing means ( Fig. 1) in the housing for receiving the motion video signal from a video camera and a processing the received motion video signal;
- a converting means for converting the motion video signal into a sequence of the still image (column 2);
- storage means (5) for storing the sequence of still images on a computer readable and writable random access medium mounted in the housing (column 3);
- means for specifying a sequence of still images ( video clip or different video clips) to be reproduced (column 3, lines 1-41) ; and
- a motion camera (video camera) )for providing the moving picture to the recorder (Fig. 1).

Peters at figure 1 fails to specifically teach that the motion camera mounted in the housing having the recorder. However, it is noted that combining a camera with recorder for making a portable apparatus is well known in the art as taught by Kojima (Fig. 1 , column 1 lines 5-10) . Therefore, it would have been obvious to one of ordinary

skill in the art to modify the digital recorder of Peters with Kojima by providing a motion camera in the same housing of the digital recorder for portability's purpose therefore providing more advantages to the user in handling the apparatus for capturing the pictures when needed.

4. Claims 1, 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bluth et al (3,617,626) in view of Washino (5,537,157) .

Regarding claims 1, 9 and 23, Bluth discloses a digital motion picture recorder (Fig. 1 columns 3-5) comprising:

- a housing sized to be portable for use by an individual (Fig. 1);
- a motion camera (11) for providing motion video signals (column 12 lines 42-72);
- processing means ( Fig. 1) in the housing for receiving the motion video signal from a video camera and for processing the received motion video signal;
- a converting means (13) for converting the motion video signal into a sequence of the still images (frames )(column 12, lines 50-60\_);
- storage means (digital recorder means ) for storing the sequence of still images on a readable and writable random access medium mounted in the housing (column 12, lines 54-59)); and
- means for selecting a sequence of the stored sequence still images to be reproduced (column 12, lines 59-65).

Bluth fails to specifically teach that the digital still images (frames ) are stored on a computer readable and writable random access medium . However it is noted that

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processing the motion picture from a camera for processing the motion picture into still frames and storing the digital still images on a digital computer readable and writable random access medium is well known in the art as taught by Washino .

Washino teaches a processing means for processing the motion picture from a camera into a digital still images that can be recorded on digital computer readable and writable random access medium (8) (Figs. 2-3, column 6, lines 25- 45, column 8, lines 28 to column 9, line 37). It would have been obvious to one of ordinary skill in the art to modify Bluth with Wasino by using a processing means as taught by Washino for processing the motion picture from the camera into sequence of still mages that can be recorded and read on and from a digital computer random access medium thereby enhancing the function of the apparatus of Bluth to facilitate accessing and retrieving the stored digital motion picture when needed .

5. Claims 1, 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washino et al (5,488,433) in view of Freeman et al (5,579,239) and Osamu (J P405153448).

Regarding claims 1, 9 and 23, Washino et al. discloses a digital motion picture recorder (Figs 1 and 2) comprising a motion picture camera (video camera) for providing a motion video signal; means for converting the motion video signal into a sequence of digital still images and compressing the sequence of digital still image (column 4, lines 57-68); and means for storing the sequence of digital still images on a rewritable random-access medium (70) in a computer readable file form (column 10, lines 9-25).

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Washino further teaches that the digital storage medium is employed in the housing of the camera and the stored digital still picture can be implemented for editing (column 4, lines 13-32) but fails to specifically teaches an editing means in the housing of the camera for specifying a sequence of the stored digital still picture. However, it is noted that using an editing means for specifying a sequence of stored digital video signal is well known in the art as taught by Freeman. Freeman teaches an editing means used with (2) within a computer for editing a video signal captured from a video camera and recorded on a random access memory (column 2, line 59 to column 3, line 7, column 6, lines 8-20, Fig. 2) for defining a sequence of the still picture of the motion picture. Therefore, it would have been obvious to one of ordinary skill in the art to modify Washino with Freeman by installing the editing means as taught by Freeman in the recorder of Washino to enable edit the stored digital still pictures by specify a sequence of the still digital still pictures, thereby providing more convenience to the user in editing the stored digital still picture captured by the camera.

Washino as modified with Freeman fails to teach that the editing means mounted in the housing of the recorder. However, it is noted that installing an editing means within a housing of a recorder and camera is well known in the art as taught by Osamu.

It would have been obvious to one of ordinary skill in the art to modify Washino as modified with Freeman with Osamu by using the teaching as suggested by Osamu to install the editing means as taught by Freeman within the recorder of Washino thereby provide more convenience to the user in handling the editing the captured digital motion data.

Applicants agree that :

" None of the cited references alone teaches or suggests a housing sized to be portable for use by an individual, a motion picture camera mounted in the housing, a digital, computer-readable and writable random-access medium mounted in the housing and connected to receive and store the sequence of digital still images in a computer-readable file format, and a system within the housing for specifying a sequence of segments of the sequence of digital still images."

In response, the examiner disagrees. It is submitted that the combination of the cited references will teach or suggest "a housing sized to be portable for use by an individual, a motion picture camera mounted in the housing, a digital, computer-readable and writable random-access medium mounted in the housing and connected to receive and store the sequence of digital still images in a computer-readable file format, and a system within the housing for specifying a sequence of segments of the sequence of digital still images." since the Washino reference teaches a housing sized to be portable mounted with a camera and a recorder and a control system (computer) (Figs.1 and 2 column 4, lines 14-32) for processing the digital motion picture from a camera , implementing editing of the digital motion picture and recording the digital motion picture on a random access readable and writable computer medium , Freeman teaches a portable computer having means for storing the digital motion pictures and an editing means for defining sequences of the digital still pictures to be played back (column 2, line 45 to column 3 line 21) and Osamu teaches a camera having a



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housing mounted with a recorder and a system for performing editing function on the video signal.

Applicants further argue that "Any proposed combination or modification of prior art references must be explained by a reason from the prior art that is supported by substantial evidence." In response it is noted that the combination of Washino and Freeman are supported by evidence being taught and suggested by Osamu. The combination of a camera, recorder or computer and an editing means in the same housing would provide advantages to the user in handling capturing desired motion pictures and convenience to the user in selecting the sequences of the stored digital still images to be played back for viewing or editing. Providing the advantages and conveniences to the user is the reasons to motivate one of ordinary skill in the art to combine Washino with Freeman also being suggested and taught by Osamu.

Applicants further argue that Osamu does not teach an editing means for defining sequences of stored digital still picture to be read out and play back. In response, it is noted that the examiner relies on Osamu as the reference teaches the camera, recorder and editing means are mounted within the same housing to provide more advantage and convenience to the user in capturing desired picture signals and editing the picture signals. The processing digital still picture data, storing the digital still picture data and defining sequences of stored the digital still pictures are disclosed by Washino and Freeman.

***Double Patenting***

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6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1,9 and 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of copending Application No. 08/932,993. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the recited feature in claims 1,9 and 23 of the present application and claim 5 of copending Application No. 08/932,993 is that claim 5 of copending Application No. 08/932,993 additionally recite an encoder having two inputs and an output for receiving and outputting video signals that is not found in claims 1,9 and 23 of the present application. However, it is noted that eliminating an element is obvious to one of a practitioner in the art. See Elimination of an element and its function---*In re Karlson*, 153 USPQ 184 (CCPA 1963). Therefore, it would have been obvious to one of ordinary skill in the art to modify claim 5 of copending Application No. 08/932,993 by eliminating the encoder recited in claim 5 of copending Application No. 08/932,993 to produce claims 1,9 and 23 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N

  
HUY T. NGUYEN  
PRIMARY EXAMINER